

No. 11854  
IN THE  
**United States Court of Appeals**  
FOR THE NINTH CIRCUIT

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SCHICK SERVICE, INC., and SCHICK, INC.,  
*Appellants,*

*vs.*

RALPH E. JONES,  
*Appellee,*

and

RALPH E. JONES,  
*Appellant,*

*vs.*

SCHICK SERVICE, INC., and SCHICK, INC.,  
*Appellees.*

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**REPLY BRIEF FOR  
DEFENDANTS-APPELLANTS.**

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## REPLY BRIEF FOR DEFENDANTS-APPELLANTS.

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The argument upon which plaintiff relies in Appellee's Brief to sustain claims 22, 23, 31 and 32 of the patent in suit is that each of these claims "defines a *new* combination of mechanical elements" (Appellee's Br. p. 10). The alleged combination as defined by claims 22, 23 and 32 consists merely of a rounded end guard or flap which is hinged to the shaver, claim 31 leaving out the element of rounding.

In our Opening Brief (pp. 19-24) we have pointed out that there is nothing inventive either in providing a

rounded end guard or flap for a shaving razor or in hinging the guard or flap to the razor. The alleged combination upon which plaintiff relies is clearly not a patentable combination for it is totally lacking in invention. It is well settled that a combination lacking in invention will not sustain a patent. *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84, 90, 86 L. Ed. 58. As said by this court in *R. G. LeTourneau v. Gar Wood Industries*, 151 F. (2d) 432, at 434-5:

“As the Supreme Court explained in *Cuno Engineering Corporation v. Automatic Devices Corporation*, 1941, 314 U. S. 84, 90, 62 S. Ct. 37, 40, 86 L. Ed. 58: ‘We may concede that the functions performed by Mead’s combination were new and useful. But that does not necessarily make the device patentable. Under the statute, 35 U. S. C. §31, 35 U. S. C. A. §31, R. S. §4886, the device must not only be “new and useful,” it must also be an “invention” or “discovery.” \* \* \* Since *Hotchkiss v. Greenwood*, 11 How. 248, 267, 13 L. Ed. 683, decided in 1851, it has been recognized that if an improvement is to obtain the privileged position of a patent more ingenuity must be involved than the work of a mechanic skilled in the art.’ The court stated further, 314 U. S. at page 91, 62 S. Ct. at page 41, 86 L. Ed. 58, ‘A new application of an old device may not be patented if the “result claimed as new is the same in character as the original result” \* \* \* even though the new result had not before been contemplated.’ ”

In his Point No. 1 plaintiff argues that “There is no prior art of record in this case which shows or suggests the provision of separate end guards for any shaving or

hair clipping or cutting device, which are rounded to conform to the general shape of the ends of a cutting head of the device" (Appellee's Br. p. 17). The record completely refutes this assertion. A rounded end guard to provide shaving comfort is shown in the prior Peterson patent No. 1,744,280 [Ex. L-4, R. 470]. The end guards in the Peterson patent comprise the shields 4 shown in the drawings and described in the specification of the Peterson patent. The patent states that the purpose of these guards is as follows:

"It will be observed, therefore, that I have provided a safety razor which is easy to construct and maintain and which may be used to shave depressed or concave skin areas of the body, such as the arm pits without fear of injury from the corners of the razor blade. The fact of the matter is, it may be used with greater comfort upon smooth surfaces of the face and body than can the ordinary razor and my improved razor may, therefore, be said to be adapted to shave any part of the human body without fear of injury thereto." [R. 472, col. 2, lines 68-79.]

The end guards or shields 4 of the Peterson patent are formed integral with the body portion 1 of the shaver shown in the Peterson patent, but the idea of forming a separate end guard for a shaver is shown in the prior patent to Dean No. 2,014,882 [Ex. L-8, R. 490]. The separately formed guards in the prior Dean patent are the knobs 18 shown in the drawings and described in the specification of the Dean patent.



The separate forming of the end guards and their hinging to the shaver does not constitute a combination which is patentable. This is conceded by the statement in the patent in suit reading as follows:

“While I have described both guards 20 as being hinged or pivoted by means of the pivot pins 23, I do not wish to be limited to this as it is obvious that one of these guards, or both of them, might be permanently fixed in closed position and rigidly attached to the handle.” [R. 427, col. 1, lines 24-29.]

The asserted combination is thus expressly definitely disclaimed.

Appellee's Brief (p. 5) reiterates the alleged advantages set forth in the patent in suit and argues that these are due to the asserted new combination. The first of these advantages (comfort) was fully known and taught in the prior art as shown, for example, in the prior Peterson and Dean patents above-mentioned. The second of these advantages (security against interruption of the mechanical functioning of the clipping machine) is equally well shown in the prior Dean patent. So likewise is the third of the stated advantages (security against damage) inherent in the guards of the Peterson and Dean patents. Defendants do not use the fourth advantage (ease in disassembling and reassembling). This advantage in plaintiff's patent is stated in the patent to be provided by using the hinging guards to hold the head upon the handle and do away with the set screw of the Schick shaver [R. 425, col. 1, lines 24-39]. Defendants' accused shavers use a set screw to hold the head upon the handle and do not employ the whisk-it members for that purpose. The defendants' accused shavers cannot be cleaned in the manner described in the patent in suit. The manner of



cleaning described in the patent in suit is by blowing through the opening 35 [R. 426, col. 2, lines 64-70]. There is no hole in the whisk-its of the defendants' accused shavers corresponding to the opening 35. The shavers of the prior Peterson and Dean patents are just as neat in construction and appearance (plaintiff's fifth stated advantage) as the shaver of the patent in suit.

The argument upon which plaintiff relies in Appellee's Brief (pp. 26-29) to show that the defendants infringe the alleged new combination is based on a misconception of well-settled patent law. The fact that defendants' accused shavers may contain each of the elements of the claims in issue is not sufficient in patent law to show that defendants use the combination of the patent. Each of the elements of the claims in suit is admittedly old. It is well-settled patent law that a defendant may utilize each of these old elements without infringing the claims of the patent in suit if defendant's device is substantially different from that of the patent in suit and performs different functions or the same functions in substantially a different way. This is because the elements being old, the defendant is as free as the patentee was to utilize those elements, providing he produces a substantially different device.

As said in *Safety Car Heating & Lighting Co. v. Gould Coupler Co.*, 245 Fed. 755, at 760 (D. C. W. D. N. Y.):

"It is not enough, where the patentee's claims are also for a combination of old elements, for a complainant to point out substantially the same elements in combination in a defendant's structure. It must also be shown by preponderating evidence that a defendant's system performs substantially the same function in substantially the same way."

To the same effect is *Milwaukee Carving Co. v. Brunswick-Balke Collender Co.*, 126 Fed. 171, at 184 (C. C. A. 7), where the court said:

“The patent is granted for the combination, as ‘the particular means devised by the inventor by which that result is attained,’ and the patentee is entitled to protection against any use of the same combination of elements, combined in the same way, so that each element performs the same function, or against substantially the same use with deviations which are merely colorable. But each of these well-known elements remains open to the use of the subsequent inventor for a different combination for like results. *Electric Signal Co. v. Hall Signal Co.*, 114 U. S. 87, 96, 5 Sup. Ct. 1069, 29 L. Ed. 96.”

As said in *Gill v. Wells*, 22 Wall. (89 U. S.) 1, at 14:

“Valid letters patent may be granted for an invention which consists entirely in a new combination of old ingredients, provided it appears that the new combination of the ingredients produces a new and useful result; but the rule is equally well settled, in such a case, that the invention consists merely in the new combination of the ingredients, and that a suit for an infringement cannot be maintained against a party who constructs or uses a substantially different combination, even though it includes the exact same ingredients.”

See, also:

*American Steel & Wire Co. v. Denning Wire & Fence Co.*, 176 Fed. 564, at 565; affirmed 194 Fed. 117 (C. C. A. 8).

That the defendants' accused shavers embody a different combination of the admittedly old elements from that found in plaintiff's patent cannot be disputed. In the accused shavers, defendants' whisk-its do not perform substantially the same functions as in the patented device or perform these functions in substantially the same way. As pointed out in our Opening Brief, and not denied by plaintiff in his brief, defendants' whisk-its serve the purpose of a reservoir or hair collector and plaintiff's patent does not; plaintiff's guards or flaps are utilized to hold the head in position without the necessity of using a set screw and defendants' whisk-its are not.

The assertion in Appellee's Brief (pp. 2-3) that defendants have waived the defense that claims 22, 23, 31 and 32 are invalid for indefiniteness is manifestly without substance. This defense was sustained by the court below as to claims 1, 11, 17, 18, 19, 20, 24, 25, 26, 27, 28, 29 and 30, and this ruling is before this court on plaintiff's cross-appeal. This defense was urged to the court below as to all of the claims in issue of the patent in suit, including claims 22, 23, 31 and 32. In sustaining the latter claims, the court overruled the defense as to those claims. In answer to plaintiff's argument that this defense was not pleaded by the defendants, we need only call to the court's attention the language of Rule 15(b) of the Rules of Civil Procedure which provides that, when issues not raised by the pleadings are tried by express or implied consent of the parties, they shall be treated in all respects as if they had been raised in the pleadings, and that any amendments to cause them to conform to the evidence and to raise the issues may be made upon motion at any time, even after judgment, but that "failure so to amend does not affect the result of the trial of these

issues.” This rule has been applied by this court in *United States v. Cushman*, 136 F. (2d) 815. Plaintiff says that we did not suggest to the District Court any finding on this issue as to claims 22, 23, 31 and 32. These claims were sustained by the lower court, and the lower court ordered plaintiff to prepare the findings as to them [R. 417]. It is not true that defendants have not adequately specified this issue as a point on this appeal. In our Concise Statement of Points filed in the District Court pursuant to Rule 75(a) of the Rules of Civil Procedure, Point XXI [R. 85] specifies that the trial court erred in holding that claims 22, 23, 31 and 32 define a new and useful invention and are valid. Under Rule 19(6) of this court we have filed [R. 420] a Notice of Adoption of the Statement of Points filed in the District Court. In the specification contained in our Opening Brief on this appeal (p. 16), we specified: “1. The court below erred in failing to hold that claims 22, 23, 31 and 32 in suit are void for lack of invention.” In answer to plaintiff’s assertion that invention may be found in the rounding of the guards or flaps 20 of the patent in suit, we have pointed out fully in our Opening Brief that the claims do not specify the degree of roundness necessary to distinguish from the roundness admittedly present in the prior Schick shavers and that, therefore, the patent cannot be sustained on plaintiff’s argument. This constitutes Point 4 of the Summary of Argument (p. 18) set forth in our Opening Brief on this appeal, which point is covered in our Opening Brief at pages 26-30. Certainly plaintiff cannot complain that he has not been at all times fully advised of this point. He has attempted to answer the point in his brief (pp. 24-26).

Plaintiff’s argument that the word “round” is not functional is fully answered by the decision of this court in

*Farmers' Cooperative Exchange v. Turnbow*, 111 F. (2d) 728, cited in our Opening Brief on this appeal. To the same effect is the decision of this court in *Otis Elevator Co. v. Pacific Finance Corp.*, 71 F. (2d) 641, 642. Plaintiff's argument might have some validity if it were not for the fact that the prior Schick shavers were admittedly rounded to some extent to avoid scratching and cutting. The latter is admitted in Appellee's Brief (p. 18). Since the purported invention consists in an alleged greater degree of rounding, the indefiniteness of the claims is clearly established by the ruling of this court in the *Farmers' Cooperative* case aforesaid.

Plaintiff argues that the claims, when read in the light of the specification and drawings, are sufficiently definite to enable a man skilled in the art to practice the invention. In answer to this we call attention to the fact that the specification is entirely silent as to the degree of rounding. Plaintiff calls attention to the fact that Mr. Gray, Chief Engineer of defendant Schick, Inc., produced a model of the device of the patent, which model is Exhibit A. This model was made by defendants exactly in accordance with the proportions shown in the drawings of the patent in suit. No one at the trial had ever attempted to shave with this exhibit, or any device made in accordance with the drawings of the patent in suit. Plaintiff was quite uncertain on cross-examination as to whether Exhibit A was sufficient for the purpose stated in his patent [R. 179]. It is highly significant that the testimony of plaintiff as to the shaving comfort afforded by a proper rounding was based by plaintiff on his experience with one of defendants' accused Schick shavers and not on any experience with any device built in accordance with the drawings or specification of his patent.



The whisk-its in defendants' accused shavers are shaped so as to provide a reservoir to receive the beard clippings, and this shape provides them with a roundness far different in degree from anything appearing in plaintiff's patent.

The assertion that a man skilled in the art could practice the alleged invention by following the specification and drawings is not an answer to our point that the claims are void for indefiniteness. This exact proposition is settled by the decision of the Supreme Court in *General Electric Co. v. Wabash Appliance Corp.*, 304 U. S. 397, at 398, 82 L. ed. 1402, at 1405, where Mr. Justice Reed said:

"We may assume that Pacz has sufficiently informed those skilled in the art how to make and use his filament. The statute has another command."

That command is that claims definitely limit the scope of the patent so as to distinguish precisely what is covered by the patent from what is not. As further said by Mr. Justice Reed in the *Wabash* case:

"Congress requires of the applicant 'a distinct and specific statement of what he claims to be new, and to be his invention.' Patents, whether basis or for improvements, must comply accurately and precisely with the statutory requirement as to claims of invention or discovery. The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public."

It is the requirement that the claims in suit do not fulfil.

The argument in Appellee's Brief (p. 23) that the grant of the patent in suit is *prima facie* evidence of its validity

overlooks the fact that the principal prior art relied upon by defendants was not found and cited by the patent examiner. This is true of all of the prior patents referred to in our Opening Brief (pp. 8, 11-12, 20) and of the punch [Ex. N]. It is well settled that a patent is denuded of the usual *prima facie* presumption of validity where the prior art was not found and cited by the examiner. *Mettler v. Peabody Engineering Corp.*, 77 F. (2d) 56, 58 (C. C. A. 9); *Stoody Co. v. Mills Alloys, Inc., et al.*, 67 F. (2d) 807, 810 (C. C. A. 9).

The attempt in Appellee's Brief (p. 8) to support the patent in suit by the claim that defendants have recognized the alleged value and importance of the alleged invention in suit is entirely without foundation. The fact that some \$20,000,000 worth of Schick shavers have been sold equipped with defendants' whisk-its cannot avail plaintiff, because, as found by the District Court [R. 48], several times this amount of Schick shavers (1,700,000) were sold between 1931 and 1939 before the adoption of the whisk-its. Furthermore, defendants' whisk-its are not the same as the guards or flaps 20 of the patent in suit, as we have pointed out in this brief and in our Opening Brief. As pointed out by this court in *Heath v. Frankel*, 153 F. (2d) 369, 371, commercial success is of no avail to sustain the validity of a patent where the commercial success is not attributable to the patented device. It must be remembered in this case that Schick was not inspired to adopt its whisk-its by anything invented by plaintiff or shown in the patent in suit. Plaintiff first communicated his alleged invention to defendant Schick, Inc., in June 1940 [R. 232]. Defendants' accused whisk-its were first produced by Mr. Burns (Sales Manager of Schick, Inc.) in the summer of 1938 [R. 369] and Mr. Burns ac-



quired an assignment of the Meyer patent [Ex. L-2] showing the whisk-its; and they were adopted and put out by the Schick company in 1939 [R. 370]. Plaintiff admitted at the trial that he knew of their use in 1938 or early in 1939. This is not a case where the defendants copied anything from the plaintiff. Defendants had the accused devices in regular sale for a very substantial time before ever learning anything of plaintiff or his alleged invention.

It is true that, upon learning of the issue of the patent in suit, representatives of defendant Schick, Inc., called on plaintiff and endeavored to buy the patent in suit. They arrived subsequent to plaintiff having mailed a notice of infringement to their company [Ex. 8, R. 431-433]. Their attempt to buy the patent in suit under these circumstances should not be misconstrued. It was entirely logical for Schick, Inc., to attempt to purchase the patent and thereby avoid a law suit, irrespective of the strength of the patent. The time and expense involved in litigating a patent suit is a matter of common knowledge. As said in *International Flatstuck Check Book Co. v. Young & Selden Co.*, 284 Fed. 831, 832 (C. C. A. 4):

“Especially in minor patents those engaged in the trade or art often prefer to pay the license fee rather than go to the expense and trouble of contesting a doubtful patent.”

When confronted with plaintiff's successive demands, Schick, Inc., obtained the advice of its patent counsel upon the merits of the patent in suit. Its patent counsel advised plaintiff that “in the light of the prior art, we have advised the Schick Company that we do not agree with your views and that in our opinion you have no valid claim

for infringement" [Ex. C, R. 449]. In view of this advice, the Schick company refused to go further in its negotiations with plaintiff and elected to stand suit. Certainly there is nothing in these circumstances that constitutes a recognition of plaintiff's patent.

The attempt in Appellee's Brief (pp. 30-31) to find something wrong with the testimony of Quasnovsky and Gray in no manner is a response to Point 7 of our Opening Brief (p. 39), where we state that the court below erred in rejecting the testimony of these witnesses as to the manufacture and sale of Exhibits B, F, H and I. As we pointed out, the testimony of these witnesses as to these exhibits is corroborated by documents and by the admissions of plaintiff himself. Nowhere in Appellee's Brief is there any attempt to refute the testimony of these witnesses that Exhibits B, F, H and I were made and sold as stated in their testimony, and nowhere is there any attempt by plaintiff to overcome the admission of plaintiff himself that the prior Schick shavers had the degree of rounding testified to by Quasnovsky and Gray.

In attempting to sustain the finding of the court below as to wilful infringement (Appellee's Br. pp. 31-33), plaintiff is unable to deny the law to be as stated under Point 8 in our Opening Brief (p. 41), or to argue that the validity of the patent in suit was not reasonably debatable. It would be futile for plaintiff to attempt to do so because the court below has found most of the claims in issue to be invalid and admitted his doubt as to the validity of those sustained. In lieu thereof, the plaintiff charges defendant

Schick, Inc., with bad faith in the premises. This charge is the subject of plaintiff's cross-appeal. It is unnecessary for us to restate here the arguments that are being presented on that cross-appeal. There is no basis whatever for the assertion that plaintiff's charge of infringement has not been defended in this case in good faith and on the honest belief that the validity of the patent in suit is open to dispute. There is of record the letter [Ex. C, R. 449] to plaintiff from defendants' patent counsel stating that they have informed the Schick company that, in their opinion, plaintiff has no valid claim for infringement of the patent in suit. As we have shown in our answer to plaintiff's cross-appeal, the Schick company acted on this advice. With this evidence before the court, there was certainly no need for our calling an officer from the Schick company to testify that the Schick company "acted upon any belief in such advice," if indeed the court would permit such testimony.

Respectfully submitted,

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